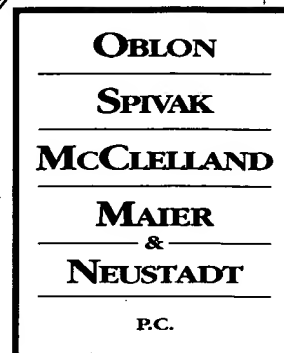


Docket No.: 213672US2

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

ECKHARD H. KUESTERS  
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RE: Application Serial No.: 09/955,080

Applicants: Kenji YAMAGUCHI, et al.

Filing Date: September 19, 2001

For: SEMICONDUCTOR DEVICE EVALUATION  
METHOD AND APPARATUS, SEMICONDUCTOR  
DEVICE MANUFACTURING CONTROL METHOD,  
SEMICONDUCTOR DEVICE MANUFACTURING  
METHOD, AND RECORDING MEDIUM

Group Art Unit: 2814

Examiner: M.D. PIZARRO CRESPO

SIR:

Attached hereto for filing are the following papers:

**PROVISIONAL ELECTION**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

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DOCKET NO: 213672US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

KENJI YAMAGUCHI ET AL. :

EXAMINER: M. D. PIZARRO CRESPO

SERIAL NO: 09/955,080 :

FILED: SEPTEMBER 19, 2001 :

GROUP ART UNIT: 2814

FOR: SEMICONDUCTOR DEVICE  
EVALUATION METHOD AND  
APPARATUS, SEMICONDUCTOR  
DEVICE MANUFACTURING CONTROL  
METHOD, SEMICONDUCTOR DEVICE  
MANUFACTURING METHOD, AND  
RECORDING MEDIUM

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated December 2, 2003, Applicants elect with traverse group III, claims 7-11, 15, and 16, drawn to an evaluation apparatus, classified in class 324, subclass 769.

The Restriction Requirement asserts that the application contains claims to distinct inventions. However, MPEP § 803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the outstanding Official Action has identified separate classifications, making a *prima facie* case of a serious burden, it is respectfully submitted that there is no serious burden in searching and examining the entire application. First of all, since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without any additional effort. Furthermore, the Classification

Definition found on the PTO website shows a search of these classifications overlap. For example, search of class 438, subclass 17 requires search of class 324. Also, search of class 360, subclass 97.01 requires search of class 341, subclass 15 and subsequently search of class 324, subclass 60+. Moreover, search of class 324, subclass 60+ (e.g., 644, 662, 671, and 699) requires search of class 716.

Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would be a serious burden on Applicants to prosecute and maintain four separate applications.

Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-20 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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